

REMARKS

Applicant has carefully reviewed the Office Action of September 21, 2009, prior to preparing this paper. Currently claims 1-9, 11, 13-16, 19, 22-24, 26 and 30 are pending in the application, wherein claims 1-4, 8, 9, 11, 13-16, 19, 22-24, 26 and 30 have been rejected, and claims 5-7 have been withdrawn from consideration. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claim Rejections under 35 U.S.C. § 112

Claims 15 and 22-24, 26 and 30 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter the applicants regard as the invention. Specifically, the language that is objected to is "substantially equal" in claims 15 and 22. Applicant respectfully traverses the rejection.

The starting point in the analysis of relative terminology is MPEP 2173.05(b), which provides that "[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification." This section teaches that "[t]he term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The Court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The Court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988)."

Applicant respectfully submits that this case is parallel to those of *In re Mattison* and *Andrew Corp. v. Gabriel Electronics*, above. Applicant teaches, in paragraph 8 of the application as published that "A spring tip, preferably including stainless steel, is positioned

about the distal portion of the core member and extends over the reinforcing member. The spring tip preferably has an outside diameter substantially equal to the diameter of the proximal portion of the core member adjacent the spring tip. Substantially equivalent diameters in this region provide for a smooth transition along the guidewire that enables medical devices to more easily pass along the guidewire during a medical procedure.” In light of this teaching, Applicant respectfully submits that one of ordinary skill in the art would know what is meant by “substantially equal.” Accordingly, Applicant respectfully submits that these claims comply with 35 U.S.C. §112, second paragraph and request the withdrawal of the rejection.

Claim Rejections under 35 U.S.C. § 102

Claims 1, 9 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Fujimoto et al., U.S. Patent Pub. No. 2003/0181828. Applicant respectfully traverses the rejection.

As a preliminary matter, Applicant notes that Fujimoto et al. are not §102(b) art, as the filing date of the instant application precedes the publication date of Fujimoto. Fujimoto et al. are available as art only under §102(e).

Fujimoto et al. do not disclose all the elements of claim 1. For example, claim 1 recites “an elongated reinforcing member having a proximal end and a distal end and an inner surface extending between the proximal and the distal end, the elongated reinforcing member disposed about the proximal portion of the distal section such that the distal portion of the distal section is free of the reinforcing member and such that the inner surface of the elongated reinforcing member is in contact with the proximal portion from the proximal end to the distal end.”

Fujimoto et al. do not teach or suggest an elongate reinforcing member having an inner surface in contact with the proximal portion of the core member from the proximal end (of the reinforcing member) to the distal end (of the reinforcing member). In the Office Action, the Examiner suggests that contact of the entire inner surface (for that is what from the proximal end to the distal end must mean) happens through the distal weld 9. Applicant believes this is mistaken on two levels.

First, if there is any intervening material there is no contact between two elements. One cannot, for example, say that the front bumper of a car is in contact with the rear bumper of the

car simply because they are joined by the car frame. That is not what "in contact" means or what it is understood to mean by those of skill in the art.

Second, the phrase includes "from the proximal end to the distal end." This level of detail in the recitation precludes the more limited contact suggested in the Office Action. When one says that a surface is in contact with an element from a first end of that surface to a second end of the surface, the whole of the surface is understood to be in contact with the element. When, for example, I say that the side of my pencil is in contact with my desk from the point to the eraser, the pencil must be lying down on the desk for that to be true (and, in the reference to the first point above, there must be no intervening paper or other material between the pencil and the desk). One cannot say the side of the pencil is in contact with the desk from its point to its eraser if the pencil is standing up on its eraser on the desk. One cannot say then that the side of the pencil is in contact with the desk through the eraser. It is simply not a meaning that those words carry. In like manner, saying that the inner surface of the elongate reinforcing member is in contact with the proximal portion from the proximal end to the distal end cannot be interpreted as being in contact solely through the distal end of the elongate reinforcing member; that is broader than the broadest reasonable definition and broader than those of skill in the art would understand the phrase to mean.

Claim 1 also recites "the outer coil member located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member." In Fujimoto et al., at least elements 9 and 33 intervene between the distal and proximal portions of the perimeter of the elongate reinforcing member, and thus it cannot be said that there exists an unoccupied space between the *entire* perimeter. Alternatively, because the reinforcing member of Fujimoto et al. is a solid wire that is on one side of the core member, the core member is an intervening element between the perimeter of the reinforcing member and the outer coil member. Thus, in Fujimoto et al. there does not exist an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member, as recited in claim 1.

For at least these reasons, therefore, Applicant submits that Fujimoto et al. do not anticipate claim 1 or dependent claims 9 and 11. Applicant consequently respectfully requests the withdrawal of the rejection and submit that these claims are in condition for allowance.

Claim Rejections under 35 U.S.C. § 103

Claims 2-4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fujimoto et al. in view of O'Connor et al., U.S. Patent No. 6,887,235. Applicant respectfully traverses the rejection.

O'Connor et al. are cited for teaching a reinforcing member with a helical groove for the purpose of providing desired torque and flexibility characteristics to the reinforcing member without requiring additional components, but, so far as Applicant can tell, O'Connor et al. do not remedy the deficiencies of Fujimoto et al. as discussed above. Fujimoto et al. in view of O'Connor et al., therefore, do not disclose each and every element of independent claim 1, from which claims 2-4 depend. Because the cited references do not disclose or suggest each and every element of claims 2-4, no *prima facie* case of obviousness has been made, and Applicant respectfully submits that these claims are in condition for allowance.

Claims 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Fujimoto et al. in view of Palermo et al., U.S. Patent No. 5,769,796. Applicant respectfully traverses the rejection.

Palermo et al. are cited as teaching a guide wire having a portion with a non-circular cross section, but, so far as Applicant can tell, Palermo et al. do not remedy the deficiencies of Fujimoto as discussed above. Fujimoto et al. in view of Palermo et al., therefore, do not disclose each and every element of independent claim 1, from which claim 8 depends. Because the cited references do not disclose or suggest each and every element of claim 8, no *prima facie* case of obviousness has been made, and Applicant respectfully submits that claim 8 is in condition for allowance.

Claims 13-16 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fujimoto et al. in view of O'Connor et al. Applicant respectfully traverses the rejections.

Claim 13 recites "wherein the reinforcing member contacts the core member along the length" and "the outer coil member located exterior of the elongated reinforcing member such that there exists an unoccupied space between the entire perimeter of the elongated reinforcing member and the outer coil member." Applicant therefore submits that these independent claims are in condition for allowance for at least the reasons discussed above with respect to claim 1.

As claims 14-16 and 19 depend from claim 13 and contain additional elements, Applicant submits that these claims are in condition for allowance as well.

Claims 22-24, 26 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shireman et al., U.S. Patent No. 7,182,735, in view of O'Connor et al. Applicant respectfully traverses the rejections.

Shireman et al. are not available as prior art. Shireman et al. were published after the filing of the instant application and was, at the time the claimed invention was made, owned by same person or subject to an obligation of assignment to the same person. The assignments for both are recorded at the USPTO. Both Shireman et al. and the instant application are assigned to and were from their conception subject to assignment to Scimed Life Systems, Inc. Under 35 U.S.C. §103(c), therefore, Shireman et al. are not available as prior art.

Accordingly, Applicant submits that claims 22-24, 26 and 30 are allowable over Shireman et al. in view of O'Connor et al.

Conclusion

Reconsideration and further examination of the rejections are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Alan Eskuri

By his Attorney,

Date: _____

1/19/2010


J. Scot Wickhem, Reg. No. 41,376
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349